

## Remarks

Reconsideration and the timely allowance of the pending claims, in view of the following remarks, are respectfully requested.

In the outstanding Office Action, the Examiner rejected claims 11 and 33-34, under 35 U.S.C. §112, ¶1, as allegedly failing to comply with the written description requirement; rejected claims 11 and 33-34, under 35 U.S.C. §112, ¶2, as allegedly containing indefinite terms; and rejected claims 11 and 33-34, under 35 U.S.C. §102(e), as allegedly being anticipated by Houser '685. The Examiner also objected to the Drawings.

By this Amendment, Applicants have amended claims 11 and 33-34. No new matter has been introduced.

With regard to the Drawing objections, Applicants submit that the claimed non-zero angle and tool have already been depicted by the embodiments shown in FIG. 1. That is, the disclosed embodiments clearly depict guide rod 5 having an incline that comprises a non-zero angle relative to the vertical axis of the apparatus body. Also, the corresponding written description clearly states that guide rod 5 inclines at an appropriate angle with respect to the vertical axis. (See, Specification: par. [00021]). Because both the Drawings and written description clearly support the claim limitation, there is no need to amend the Drawings. Accordingly, the immediate withdrawal of the objection to the Drawings is respectfully requested.

Applicants traverse the §112, ¶1, §112, ¶2, and §102(e) rejections for the following reasons:

### I. Rejections Under §112, ¶1.

In the §112, ¶1 rejection, the Examiner asserted that the claim terms "bellows mechanism" and "tool" constitute new matter. Applicants respectfully disagree.

Applicants remind the Examiner that the fundamental inquiry for determining compliance with the written description requirement is not whether the *Specification recites verbatim each and every feature of a claim*, as asserted by the Examiner. Rather, it

is whether the Specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, Applicant was in possession of the invention as now claimed. "In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide an *in haec verba* support for the claimed subject matter at issue." *Purdue Pharma L.P. v. Faulding Inc.*, 56 USPQ2d 1481 (Fed. Cir. 2000), citing *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996). See also, MPEP §2173.05(e) ("[t]here is no requirement that the words in the claim **must match** those used in the specification disclosure" and "Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.").

Furthermore, "[a]n applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as **words, structures, figures, diagrams** and formulas that fully set forth the claimed invention." See MPEP §2163(I) citing *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966 (emphasis added).

With this said, the Specification clearly discloses the use "bellows 8" and its function, structure, and configuration relative to the apparatus. (See, Specification: par. [00021], [00024], [00025]; FIGs. 1, 2). So to make a distinction between "bellows" and "bellows mechanism" and further assert that the claim term "bellows mechanism" comprises new matter can only be based on the misguided belief that claim terms must be recited **verbatim** in the detailed description - which is both legally incorrect and contrary to the U.S. PTO's own rules and policies.

However, in an effort to expedite the successful prosecution of the present application, Applicants have amended claim 11 to simply recite "bellows" and obviate the rejection. Applicants have also deleted all recitations regarding the term "tool", given that after a detailed review the numerous references asserted throughout prosecution, this element appears to be superfluous and adds very little to the patentability of the claimed subject matter.

Accordingly, the immediate withdrawal of the §112, ¶1 rejections is respectfully requested.

## **II. Rejections Under §112, ¶2.**

The Examiner asserted that the claim phrases "the lower portion," "into a jet pump of the nuclear reactor," and "a tapered surface of an opening of the jet pump" lacks antecedent basis. Applicants strenuously disagree with the rejections of the latter two phrases.

Applicants point out that the Examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, must be whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. The Examiner should allow claims which define the patentable subject matter with a **reasonable** degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the Examiner might desire. See, MPEP §2173.02.

However, again, in an effort to solely expedite the successful examination of the present application, Applicants have amended the preamble of claim 11 to recite "An apparatus for performing an operation ***inside a jet pump of a nuclear reactor in which the jet pump includes an opening with a tapered surface***". This should satisfy the Examiner's misguided need for express "qualifications" in the preamble of the claim as noted in the Office Action. (See, Office Action: items 8-9).

Applicants further submit that the phrases regarding the jet pump and the tapered surface of the jet pump opening are also recited in the body of claim 11. As instructed by the MPEP, "[i]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See, MPEP §2111.02.

As such, the positively recited jet pump and tapered surface of the jet pump opening are not only definite, they must be given patentable weight. Accordingly, the immediate withdrawal of the §112, ¶2 rejections is respectfully requested.

### **III. Rejections under §102(e).**

The Examiner rejected claims 11 and 33-34, under §102(e), as allegedly being anticipated by Houser '685, on the basis that some of the limitations are functional and based on intended use and, in his opinion, do not carry patentable weight. Applicants strenuously disagree as these assertions are not only legally incorrect, they contradict what the Examiner previously agreed to and acknowledged.

Applicants remind the Examiner that during the Interview of February 3, 2009, Applicants pointed out to the Examiner that prevailing case law (as well as the MPEP) do not regard functional language as unpatentable *per se*. Indeed, the Federal Circuit has indicated that, in some instances, functional language reciting the relative arrangement and sizing of structural elements, ***may be the best way to recite parts of an apparatus*** and must be given patentable weight. Case in point, in the *Orthokinetics v. Safety Travel Chairs*, 806 F.2d 1565 (Fed. Cir.) case, the Federal Circuit held that the functional language "***wherein said front leg portion is so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof***" was clearly definite and to be afforded patentable weight. The Federal Circuit opined that the claim was intended to cover the use of the invention with various types of automobiles and that a particular chair on which the claims read may fit within some automobiles and not others is of no moment.

The Federal Circuit specifically declared that the phrase "so dimensioned" ***is as accurate as the subject matter permits, automobiles being of various sizes***. (See, *Rosemont, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540, 1547, 221 USPQ 1, 7 (Fed.Cir.1984)). ***As long as those of ordinary skill in the art realized that the dimensions could be easily obtained, Sec. 112, 2d p requires nothing more***. The patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.

Consistent with this, Applicants have fashioned certain functional limitations that are perfectly in line with the teachings of *Orthokinetics*. That is, claim 11, which is directed to an apparatus, recites limitations that, although functional, properly define the structural features therein in terms size and relative arrangement (i.e., "**sized to be essentially fully inserted** into a jet pump" or "the inclined configuration of the guide rod **facilitates entry of the guide rod into a tapered surface of an opening of the jet pump**"). These limitations **must** be accorded the patentable weight that they are due. Indeed, in the Final Office Action of May 11, 2009, the Examiner agreed with the Applicants on this very point. It is, at best, extremely inconsistent that the Examiner now asserts that these limitations are to be ignored. (See, Final Office Action: page 8, item c).

Moreover, to legally justify the applicability of a §102 rejection, the MPEP specifies that "[a] claim is anticipated **only if each and every element as set forth in the claim is found**, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). **The elements must be arranged as required by the claim**, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). See, MPEP 2131.

And, although the rejection is based on §102 anticipation rather than §103 obviousness, Applicants submit that there must at least be some technical relevance or similarity between the asserted reference and the claimed subject matter. For example, the MPEP states that "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which,

because of the matter with which it deals, *logically would have commended itself to an inventor's attention in considering his problem.*"); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the *general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved*). MPEP 2141.01(a).

To be clear, the Houser '685 reference is directed to localized tissue stabilization for stabilizing tissue during, for example, a beating heart or off-pump coronary artery bypass grafting (CABG) procedure. (See, Houser '685: par. [0002]). The embodiments of Houser '685 relied upon by the Examiner disclose a super-elastic or shape memory tissue retractor **800** for minimally invasive heart valve surgery or even other non-cardiovascular minimally invasive surgeries (e.g., laparoscopic, endoscopic, robotically assisted, and port access surgeries). The retractor **800** includes a handle **805**, an arm **810**, a foot **815**, and a delivery tube **820**. The handle includes one or more ports **825** that are used, for example, to supply vacuum or a fluid. The port **825** connects to one or more channels (not shown) that pass through the handle **805** and the arm **810** and terminate in the foot **815**. The foot **815** includes an atraumatic surface **830** and openings **835** that connect to one or both of a vacuum line and a fluid line that are part of the channels connected to the ports **825**. (See, Houser '685: par. [0195]; FIGs. 62-64). The arm **810** and/or foot **815** can be fabricated from either a shape memory material or a superelastic material. If a superelastic material is used to fabricate either or both of the arm **810** and foot **815**, the arm and foot can be bent such that they can be inserted into the delivery tube **820** for delivery through a narrow opening into a body cavity. (See, Houser '685: par. [0196]; FIG. 62).

Applicants fail to understand how the Examiner can legally justify that the Houser '685 reference teaches "each and every element" as set forth in the claim. Nor do the Applicants understand how Houser '685 is remotely associated with *the field of Applicant's endeavor or is reasonably pertinent to the particular problem with which the Inventor was concerned*.

Applicants remain equally puzzled as to the Examiner can reasonably allege that the flexible surgical apparatus of Houser '685, which is specifically designed to be delivered into a narrow opening of a human body cavity for cardio-vascular surgery, can be used in the "same manner and for the similar purpose" as performing the claimed ***operation inside a jet pump of a nuclear reactor in which the jet pump includes an opening with a tapered surface***, as alleged by the Examiner. (See, Office Action: page 7, item 13).

At the risk of overstating the obvious, independent claim 11 is directed to an apparatus for performing an ***operation inside a jet pump of a nuclear reactor in which the jet pump includes an opening with a tapered surface***. To this end, the claim positively recites, *inter alia*, an ***apparatus body having an elongated tubular member sized to be essentially fully inserted into the jet pump of the nuclear reactor***, the tubular member having an upper portion that defines a top end of the apparatus body and is attached to a wire for support . . . a ***weight for imparting gravitational force on the apparatus body, the weight having an upper portion that is coupled to a lower portion of the tubular member via a bellows*** . . . wherein, ***the biased, predetermined non-zero angle of the guide rod facilitates entry of the guide rod into the tapered surface of the jet pump opening***, and wherein, ***after the guide rod is inserted into the jet pump opening, the apparatus body is lowered via the wire so that the apparatus body is essentially fully inserted into the jet pump*** to perform the operation.

There can be no denying that Houser '685 is absolutely devoid of performing any ***operation inside a jet pump of a nuclear reactor in which the jet pump includes an opening with a tapered surface***. Nor is there anything in Houser '685 that suggests an ***apparatus body having an elongated tubular member sized to be essentially fully inserted into the jet pump of the nuclear reactor*** or that ***the biased, predetermined non-zero angle of the guide rod facilitates entry of the guide rod into the tapered surface of the jet pump opening***.

Finally, in an attempt to establish a basis for the §102 rejection, the Examiner asserted that element 855 of Houser '685 corresponds to the claimed weight. (See, Office Action: page 6, item 13). However, Houser '685 specifically defines element 855 as a delivery tube, which has nothing to do with a weight or operate as such. Indeed, Houser

'685 states that "[a]s illustrated in FIGS. 65 and 66, surgical device **850** includes a J-shaped instrument **853** that is passed through a **delivery tube 855** such that a J-shaped portion **860** of the instrument is delivered to a surgical site to move, reposition or manipulate tissue." (See, Houser '685: par. [0199]). Houser '685 also goes on to state that "[s]imilarly, in FIGS. 67 and 68, a surgical device **865** includes a hockey shaped instrument **867** that has a hockey-stick shaped portion **870** that can be advanced in whole or in part from the **delivery tube 855** such that the instrument forms an angled member that varies with respect to the delivery tube between collinear to any desired angle based on the angle imparted in the instrument **867** during fabrication." (See, Houser '685: par. [0200]).

Applicants remind the Examiner that the claimed invention recites a configuration in which a guide rod, which is elastically biased toward a predetermined, non-zero angle, is connected to the lower portion of the weight. With this configuration, once the weight is inserted into the jet pump followed to the guide rod, the gravitational force act on the weight allows the apparatus as a whole drawn into the jet pump. (See, also, Specification: par. [00024]). Clearly, delivery tube **855** cannot be construed as the claimed weight.

Thus, for at least these reasons, Applicants submit that the Houser '685 does not anticipate or, for that matter, render claim 11 unpatentable. As such, claim 11 is clearly patentable and claims 33-34, which depend from claim 11 are also patentable by virtue of dependency as well as for their additional recitations. Accordingly, the immediate withdrawal of the §102 rejection is respectfully requested.



### Conclusion

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.


If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

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